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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/644,777	08/23/2000	Roger P. Jackson	10,033	1641

7590

06/03/2003

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EXAMINER

MELSON, CANDICE C

ART UNIT PAPER NUMBER

3732

DATE MAILED: 06/03/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/644,777

Applicant(s)

JACKSON, ROGER P.

Examiner

Candice C. Melson

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13-16, 18, 21 and 27-49 is/are allowed.
- 6) ☒ Claim(s) 1-7, 11, 17, 19, 20 and 22-26 is/are rejected.
- 7) ☒ Claim(s) 8-10 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Abstract

The abstract of the disclosure is objected to because it contains grammatical errors. In particular, lines 1-2 contain an incomplete sentence. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1) Claims 1-7, 11, 17, 19-20, and 22-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Reed (USPN 5,499,892). Reed shows a “threaded shaft 50 includes threads 60 thereon which include an upper surface 66 and a lower surface 68 (FIG. 3) which extend upward toward the head 20 from a minor diameter to a major diameter 62” (column 6, lines 30-33). These threads each consist of an inner and outer edge referred to as a “crest” and a “root”.

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Regarding Claims 2-4, in column 8, lines 26-28, Reed discloses that "the upper surface angle" "is preferably 20° but could be any angle between 0° and 90° ". The "lower surface angle" that Reed refers to" is preferably 40° but could be any angle between 0° and 90° ". The disclosed angles encompass applicant's claimed angles. In light of the above mentioned disclosures as well as Reed's Figure 3, it is clear that the "upper and lower surfaces" are non-parallel, which is clearly in anticipation of Claim 7. As to Claim 11, note Figure 5, which shows a discontinuous threadform. With regards to Claim 17 Reed discloses that "both the crest 70 (outer edge) and root 80 (inner edge) exhibit a constant distance from the central axis 2 between the upper edge 72 and the lower edge 74 and between the top edge 82 and the bottom edge 84" (column 8, lines 10-13). In addition with an upper surface angle of 20° and a lower surface angle of 40°, it is clear that the threads would form a triangular cross-section and more specifically an obtuse triangular cross-section, as set forth in Claims 19 & 20. Claims 22-25 are also rejected for the same reasons shown above for rejections of Claims 2-4. Lastly, Reed also anticipates Claims 26 in that the trailing and leading surfaces are not parallel and both slope rearwardly. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Allowable Subject Matter

Claims 8-10, and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 13-16,18,21, and 27-49 are allowed.

Response to Arguments

Applicant's arguments filed 03/04/03 have been fully considered but they are not persuasive. Applicant submits, "Reed does not anticipate the present invention because Reed is directed to a connector not to a closure of the type claimed". Applicant further submits that "the closure plug the present invention is directed to a plug that pushes down or bias against a rod which in turn creates outward directed forces against the arms, when normal V threads are used, which splays the arms. The reverse threads when used with in the present invention allow pressure to be exerted against a rod by the closure while resisting splaying of the arms". Examiner submits that Reed's device acts as a closure plug and is capable of being used in combination with a second medical implant. Furthermore "viewed form a first vantage point it is an object of the present invention to provide a method for repairing two opposite sides a crack in a material having a surface by forcing opposite sides of the crack together" (column 4, lines 18-21). Examiner also submits that to one of ordinary skill in the art it would be obvious that Reed's closure device is also capable of closing two opposite walls of an implant by forcing opposite walls of the implant together. Lastly, Applicant is only claiming a threadform and is not positively claiming the implant. Thus the rejections for claims 1-7,11,17,19-20, and 22-26

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are upheld.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Candice C. Melson whose telephone number is (703) 305-8128.


The examiner can normally be reached on 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (703) 308-2582. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-2708 for regular communications and (703) 308-2708 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Candice C. Melson
May 30, 2003




Cary E. O'Connor
Primary Examiner